

THINGS THE UI LAW CLINIC CAN DO

- Business Organization Documents
- Employee Handbooks
- Contracts for Services
- Trademark Prosecution
- Copyright Prosecution
- Patent Registerability/Infringement Analysis
- IP assignments

THINGS WE CANNOT DO

- Patent Prosecution
- Things outside of business or IP realm

UI Law Student Work

BUSINESS FILINGS/DOCS

- 10+ Business org filings, contracts, EULAs, & employee manuals drafted

UI Law Student Work

TRADEMARKS

- 4 office action responses
- 10 pending applications
- 3 registrations

UI Law Student Work

PATENTS

- 2 registerability reports
- 1 infringement analysis

INTRODUCTION TO IP – PRESENTATION TO THE ISB BUSINESS & CORPORATE LAW SECTION

April 14, 2021

**PARSONS
BEHLE &
LATIMER**

Forms of Intellectual Property

Patents

- Protect inventions from unauthorized use. Provides right to exclude others.

Copyrights

- Protect creative content from copying and unauthorized use.

Trade Secrets

- Protect commercially valuable secrets.

Trademarks

- Protect consumers and a producer's established goodwill

Origins of Legal Protection



- **Constitution, Article I, § 8, cl. 8**
 - “The Congress shall have Power . . . *To promote the Progress of Science and useful Arts*, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”
- **Federal Law**
 - Lanham Act
 - Defend Trade Secrets Act


FUN FACT

The power of the federal government to register trademarks comes from the commerce clause of the Constitution.

PATENT

What is a patent?

- A property right
– to **exclude**
others
- from making,
using, selling,
offering for
sale, or
importing the
claimed
invention **in the
United States**

			
		US005644170A	
United States Patent [19]		[11] Patent Number:	5,644,170
Bynum et al.		[45] Date of Patent:	Jul. 1, 1997
<hr/>			
[54]	VECHICLE MOUNTED ATMOSPHERIC/ AQUA TURBINE HAVING SPEED RESPONSIVE INTAKE MEANS	3,374,849 3/1968 Redman	180/2.2
		3,444,946 5/1969 Waterbury	180/2.2
		3,556,239 1/1971 Spahn	180/65.2
		4,229,661 10/1980 Mead et al.	290/44
[76]	Inventors: David A. Bynum , 247 Vine St., Keller, Tex. 76244; Johnnie J. Bynum , 7314 Bridges Ave., Ft. Worth, Tex. 76118		
[21]	Appl. No.: 390,072		
[22]	Filed: Feb. 17, 1995		
[51]	Int. Cl. ⁶ F03B 13/10; F03D 9/00		
[52]	U.S. Cl. 290/43; 290/44; 290/54; 290/55		
[58]	Field of Search 290/43, 44, 54, 290/55		
[56]	References Cited U.S. PATENT DOCUMENTS		
		<i>Primary Examiner</i> —Steven L. Stephan <i>Assistant Examiner</i> —Christopher Cuneo	
		[57]	ABSTRACT
		The Atmospheric/Aqua Turbine is an apparatus for produc- ing energy by allowing air or water to be metered by controls through an adjustable air or water scoop into twin turbines to produce electricity when the atmospheric/Aqua Turbine is installed on vehicle or a boat and the vehicle is travelling at 30 mph or more or in the case of the boat the boat is travelling at 8 to 10 mph or more.	

Life of a Patent

- **File** application at USPTO
 - Draft an application, drawings, claims
- Patent Pending
 - **Examination**
 - Rejection and Appeal
 - Allowance
 - Creates a **File History**
 - ~26.7 months
- Post **Issuance**
 - Licensing
 - **Litigation** (Enforcement)
- **Expiration**
 - 20 years from filing date
 - Public Domain



U.S. Patent & Trademark Office
Alexandria, VA

www.uspto.gov

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LATIMER

What is patentable?

- Any new and useful and non-obvious
 - process,
 - machine,
 - article of manufacture, or
 - composition of matter, or
 - any new and useful improvement thereof.
- Any new, original and ornamental design for an article of manufacture
- Distinct and new varieties of plants

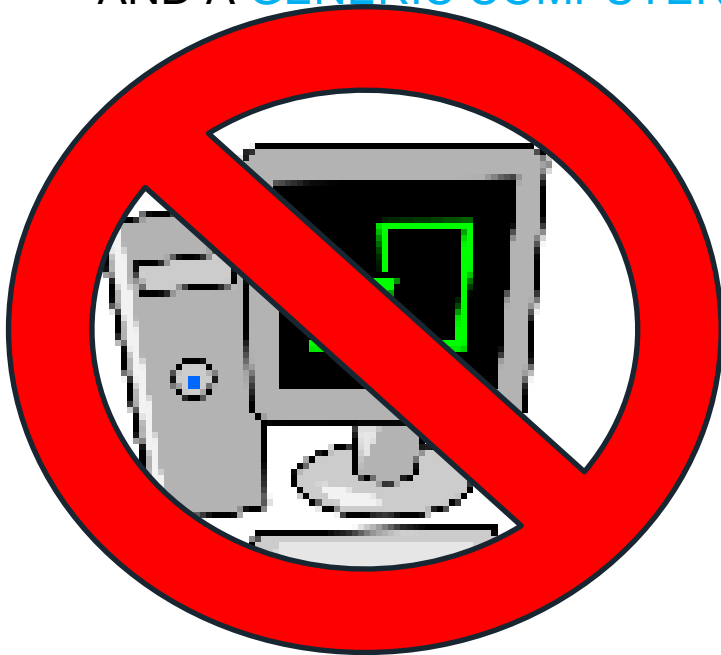
What is not patentable?

1. Scientific theories or principles
2. Laws of nature – natural phenomena
3. Abstract ideas



What about software?

IS IT JUST AN “ABSTRACT IDEA”
AND A **GENERIC COMPUTER**



Alice Corp. v. CLS Bank International, 573
U.S. ___, 134 S. Ct. 2347 (2014)

IS THE CLAIMED SOLUTION
NECESSARILY ROOTED IN
COMPUTER TECHNOLOGY TO
OVERCOME A PROBLEM
SPECIFICALLY ARISING IN THE
REALM OF COMPUTERS?

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<!--For more information go to http://www.nexchange.com-->
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DDR Holdings, LLC v. Hotels.com
L.P., 773 F.3d 1245 (Fed. Cir. 2014)

PARSONS
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LATIMER

Design patents

- Protect ornamental designs
- Protect the “look” of the object
- Doesn't protect function

U.S. Patent

Nov. 17, 2009

Sheet 1 of 2

US D604,305 S

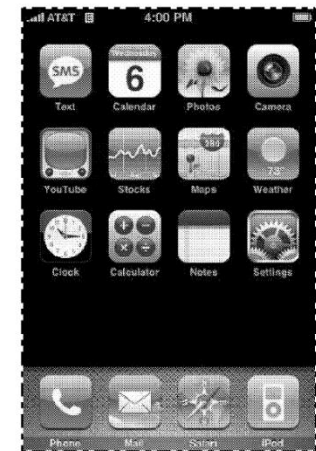
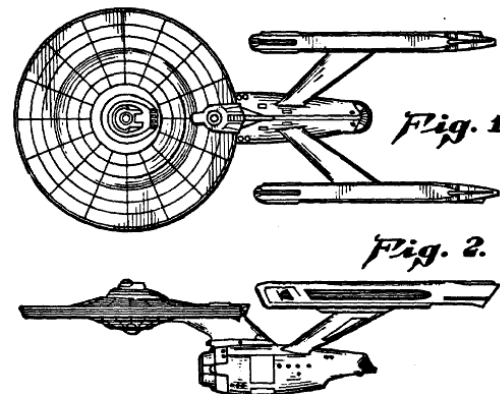


FIG. 1

STATUE OF LIBERTY - 1879



ORIGINAL COKE BOTTLE - 1915



COPYRIGHT

What is a Copyright?

Protects What?

- The rights of a creator of an *original* work that has been fixed in a tangible form of expression

Scope?

- Exclusive rights to: reproduce, prepare derivative works, distribute copies, perform/display

How Long?

- It depends

Acquiring Copyrights

Requirements

- Originality
- Authorship
- Fixation
- Creative Expression

Formalities

- Automatic upon creation of the work
- Registration required before lawsuit



What Works are Protected?

- ☐ Literary works
- ☐ Musical works and sound recordings
- ☐ Dramatic works
- ☐ Pantomimes and choreographic works
- ☐ Pictorial, graphic, and sculptural works
- ☐ Motion pictures and other audiovisual works
- ☐ Architectural works
- ☐ Face tattoos

Individual Words and Short Phrases are Generally Not Protected

To be protected by copyright, a work must contain a certain minimum amount of authorship in the form of original literary, musical, pictorial, or graphic expression.

Names, titles, and other short phrases do not meet these requirements.





Life of a Copyright

- **File application** w/ Copyright Office (Library of Congress)
 - Fill out a form, submit a deposit
- **Registration period**
 - No Substantive Examination
- **Post Issuance**
 - Licensing
 - Litigation (Enforcement)
- **Expiration**
 - Depends on whether created before or after Jan. 1, 1978
 - Life of the author + 70 years
 - If “work for hire” shorter of
 - 95 years from publication, or
 - 120 years from creation
 - End of term = public domain
 - <https://www.copyright.gov/circs/circ15a.pdf> for copyright duration



U.S. Copyright Office
Library of Congress
Washington, D.C.

www.copyright.gov

Mickey Mouse Copyright Conspiracy Theory

- Some claim that every time MM is about to enter public domain, copyright law is extended
- Has been extended twice thus far, set to enter public domain in 2024.
- Copyleft/Grassroots movement likely to quash any further attempts

Social Media Platform Terms of Services/Terms of Use w/Respect to IP Rights

- Facebook ToS Section 3: **“The permissions you give us”**
 - You own the intellectual property rights (things like copyright or trademarks) in any such content that you create and share on Facebook and the other Facebook Company Products you use. Nothing in these Terms takes away the rights you have to your own content. You are free to share your content with anyone else, wherever you want.

Social Media Platform Terms of Services/Terms of Use w/Respect to IP Rights

- Facebook ToS Section 3 cont'd
 - **However**, to provide our services we need you to give us some legal permissions (known as a 'license') to use this content. This is solely for the purposes of providing and improving our Products and services as described in Section 1 above.

Social Media Platform Terms of Services/Terms of Use w/Respect to IP Rights

- Facebook ToS Section 3 cont'd
 - Specifically, when you share, post, or upload content that is covered by intellectual property rights on or in connection with our Products, you grant us a non-exclusive, transferable, sub-licensable, royalty-free, and worldwide license to host, use, distribute, modify, run, copy, publicly perform or display, translate, and create derivative works of your content (consistent with your privacy and application settings). This means, for example, that if you share a photo on Facebook, you give us permission to store, copy, and share it with others (again, consistent with your settings) such as service providers that support our service or other Facebook Products you use. This license will end when your content is deleted from our systems.

Social Media Platform Terms of Services/Terms of Use w/Respect to IP Rights

- Facebook ToS Section 3 cont'd
 - You can delete content individually or all at once by deleting your account.
 - When you delete content, it's no longer visible to other users, however it may continue to exist elsewhere on our systems this license will continue until the content has been fully deleted.

TRADEMARK

What is a Trademark?

- Any word, name, symbol, or device, or any combination thereof, used by a person to identify and distinguish his or her goods [or services] from those of others
- Identifies the source of the products/services
- Right arises upon use, not upon claim
- Rights are limited by field of use (think of Apple)
- Term: Perpetual with continued use/proof of that use to USPTO (filing fees \$\$)

What is a Trademark?



Google Search

I'm Feeling Lucky

What is a Trademark?



“The mark consists of the color blue used on the artificial turf in the stadium.” TM Reg. No. 3707623

Life of a Trademark

- **File** application at USPTO
 - Fill out a form, submit specimen if using already
- Registration Pending
 - **Examination**
 - Use TM or SM
 - Refusal and Appeal
 - Published for opposition
 - Allowance ®
- Post Issuance
 - Licensing
 - Litigation (Enforcement)
- **Expiration**
 - Can stay registered as long as still used in commerce (can't just hold them) and maintenance fees are paid



U.S. Patent & Trademark Office
Alexandria, VA

www.uspto.gov

What can be a Trademark?

- Word, name, symbol, design, or combination of these (think word marks/logos)
- Color
- Smell
- Sound

Fun Marks!



COLOR

❖ Tiffany Blue



❖ Target Red



❖ UPS Brown

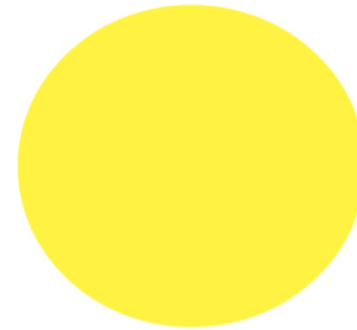


More Colors!

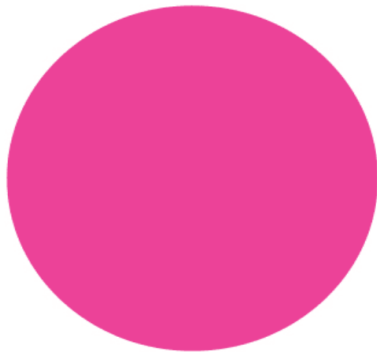
3M CANARY YELLOW



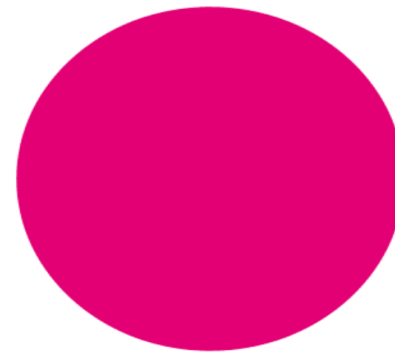
WIFFLE BALL BAT YELLOW



BARBIE PINK



T-MOBILE MAGENTA



Fun Marks!

➤ SCENT

- ❖ Verizon's "flowery musk scent" for their stores
- ❖ Bushnell's "banana and evergreen, with a hint of ammonium and kerosene" for gun-cleaning preparations

More Smells!

- ❖ Bubble gum scent for sandals
- ❖ Piña Colada Scent to Coat Ukeleles
- ❖ The Coconut smell that fills flip flop stores
- ❖ “Minty” Pain Relief Patches

Fun Marks!

➤ CORONAVIRUS-RELATED MARKS

❖ Quaranfeast Since Coronavirus 2020

- Online social networking in the field of food. (1A)



❖ #CORONAVIRUS

- All manner of clothing, including “running costumes” (1B)

❖ Love In The Time of CORONAVIRUS

- “[Romantic] advice in era of corona virus,” among many other g/s (1B)

❖ FXCK CORONAVIRUS

- Hats; T-shirts (1B)

Fun Marks!

➤ SOUNDS

- ❖ <https://www.uspto.gov/sites/default/files/73553567.mp3>
- ❖ <https://www.uspto.gov/sites/default/files/75676156.mp3>
- ❖ <https://www.uspto.gov/sites/default/files/76163189.mp3>

Considerations *before* filing

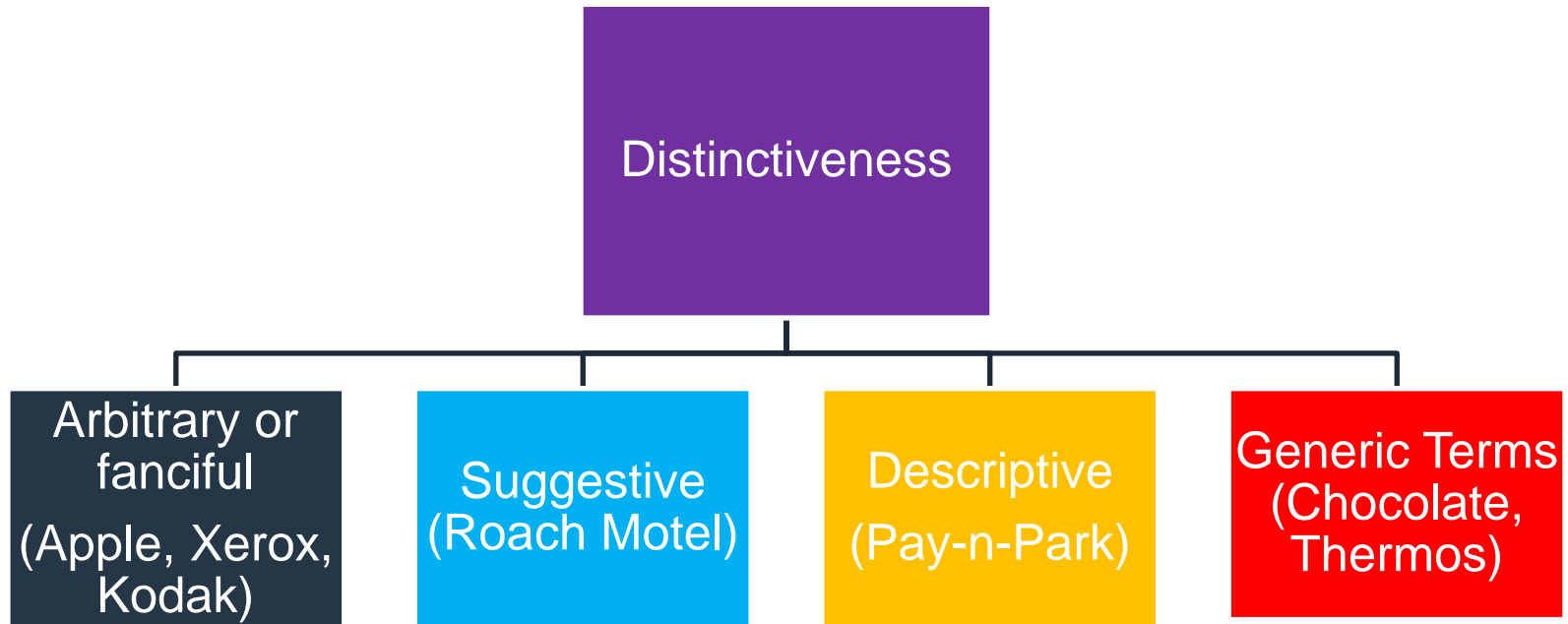
During
Examination

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graph TD; A[During Examination] --> B[Is the mark distinctive as applied to the goods or services?]; A --> C[Is the mark confusingly similar to another mark?];
```

Is the mark
distinctive as
applied to the
goods or services?

Is the mark
confusingly similar
to another mark?

Criteria for Choosing a Trademark



Fanciful



Arbitrary



Suggestive



android



Descriptive

- BUFFERIN (buffered aspirin)
- CAR FRESHNER (car deodorizers)



Generic



Should have called it *Aspirin brand* acetylsalicylic acid

Trademark Rights

Based on priority of use.

Exclude others from using confusingly-similar marks.

Rights arise under state and federal law.

Domain names fall generally within the area of trademark rights; cybersquatting.

Symbols before/after registration

- Before:

TM

SM

- After:

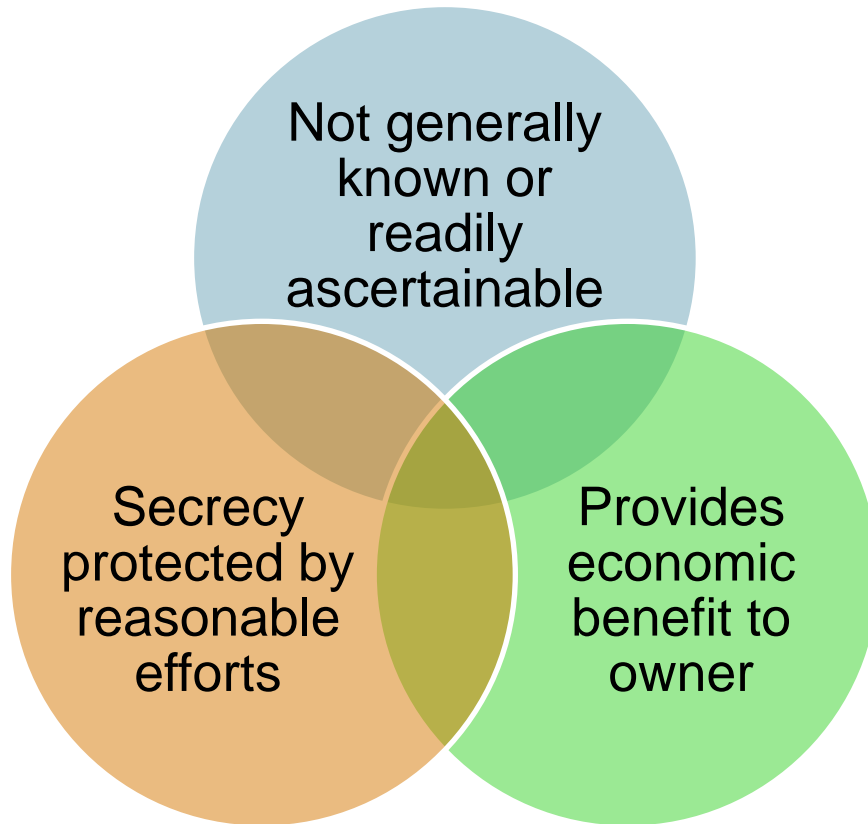


TRADE *SECRETS*

What is a Trade Secret?



Characteristics of Trade Secret



- 18 U.S.C. § 1832 – Theft of trade secrets
 - up to 10 yrs in jail or \$5M in fines
- Idaho Trade Secret Statute
<http://www.legislature.idaho.gov/idstat/Title48/T48CH8.htm>

Life of a Trade Secret

- **File** application at the trade secret office.
- **Just kidding**
- Not filed anywhere – put it in a vault
- Must take steps to keep the **secret**
 - NDA
 - Employee secrecy obligations
 - Limit access
- **Expiration**
 - As long as you can keep it a secret
 - Competitors can “reverse engineer” if they are able to



U.S. Trade Secret Office
Somewhere outside Gotham City

Protecting IP - Trade Secrets

NDA's

Employee confidentiality agreements

Secure networks and storage

Confidential info handling and storage policies

Limiting disclosure



"You spelled 'confidential' wrong."

Trade Secrets – Pros and Cons

ADVANTAGES

- Last (potentially) forever
- Cost savings?
- Immediate rights
- No agency review
- Can cover “abstract ideas”
- State and Federal Enforcement

DISADVANTAGES

- Reverse engineering
- Vulnerable to theft
- Immediate loss of rights
- Must keep secrets
- No agency review

Examples of Repercussions

Idaho Statesman

BUSINESS

This Boise tech company was just ordered to pay \$44 million over stolen trade secrets

ASSOCIATED PRESS AND STATESMAN STAFF



MAY 01, 2019 07:29 PM , UPDATED MAY 02, 2019 04:33 PM



Examples of Repercussions

Self-driving car engineer Anthony Levandowski pleads guilty to stealing Google trade secrets

He could face up to 30 months in prison

By Nick Statt | @nickstatt | Mar 19, 2020, 8:26pm EDT

Anthony Levandowski, the self-driving car engineer and former Google executive who joined Uber via an acquisition of his autonomous truck company Otto, has agreed to plead guilty to stealing Google trade secrets, [according to Reuters](#).

The decision is just the latest chapter in the [multi-year legal saga](#) involving Levandowski's roles in both Google and Uber's fast-growing self-driving car divisions. The lawsuit between Waymo, Alphabet's now-standalone autonomous car unit, and Uber eventually resulted in a [settlement between the two companies back in February of 2018](#). (Uber paid Waymo more than \$244 million as a result.)

But Levandowski remained on the hook for criminal charges of trade secret theft brought by the US Attorney's Office of the Northern District of California, charges that were brought primarily because Levandowski exercised his Fifth Amendment rights during the trial and refused to hand over any related documents. In August of last year, he was [charged with 33 counts](#) of theft and attempted theft of trade secrets for allegedly stealing roughly 14,000 documents from Google prior to founding and selling Otto to Uber.

**LEVANDOWSKI COULD SERVE
AS MUCH AS 30 MONTHS IN
PRISON**

As part of the plea deal, Levandowski is agreeing to one of the 33 charges in exchange for prosecutors dropping the other 32. He has also admitted he downloaded one Waymo spreadsheet file and accessed it after leaving his role at Google, although the plea agreement also says Levandowski was aware his "misappropriation" and possession of the trade secrets would do harm.

Identifying Intellectual Property – The IP Audit

Patents/Trade Secret

- Equipment, Processes, Formulas, etc.

Trademark

- Names, logos, designs, websites, trade dress, etc.

Copyright

- Photographs, webpage layout, software, manuals, marketing materials, etc.

Lawyer stuff

- **FAIR USE NOTICE**

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